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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,488	05/08/2006	Yasuhiro Hidaka	3712174-548	1355
29175 K&L Gates LLP P. O. BOX 1135 CHICAGO, IL 60690	7590 12/22/2009		<div>EXAMINER</div> <div>RUST, ERIC A</div>	
			<div>ART UNIT</div> <div>2625</div>	<div>PAPER NUMBER</div>
			<div>NOTIFICATION DATE</div> <div>12/22/2009</div>	<div>DELIVERY MODE</div> <div>ELECTRONIC</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary

Application No.

10/595,488

Applicant(s)

HIDAKA, YASUHIRO

Examiner

ERIC A. RUST

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 9/21/2009; 10/20/2009

DETAILED ACTION

1. In the Amendment filed on October 20, 2009, Applicant amended claim 19-36. Accordingly, claims 19-36 are pending.

Information Disclosure Statement

2. The information disclosure statement filed September 21, 2009 fails to comply with 37 CFR 1.98(a)(3), which requires a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language, and a copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c). The IDS has been placed in the application file, but the information referred to therein, specifically, the Japanese Office Action issued June 30, 2009 for corresponding Japanese Patent Application JP 2003-365047, has not been considered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 31-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to claims 31-36, the claims are drawn to a computer readable medium. Normally, the claim would be statutory. However, Applicant's specification does not define or exemplify the computer readable medium. Accordingly, the computer readable medium could be a signal.

"A transitory, propagating signal ... is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter." (In re Nuijten, 84 USPQ2d 1495 (Fed. Cir. 2007)).

Because the full scope of the claim as properly read in light of the disclosure appears to encompass non-statutory subject matter the claim as a whole is non-statutory.

The Examiner recommends amending the claim to recite a "non-transitory computer readable medium."

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 20, 26, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claims 20, 26, and 32, “wherein each of the at least two image-processing-mode-selection images represents a different level of image processing of the image processing mode,” recited in lines 5-6 of claim 20, lines 4-6 of claim 26, and lines 5-7 of claims 32, is not clearly understood rendering the claims indefinite. For example, the Examiner cannot determine what it means to have a different level of image processing of the image processing mode. For purposes of examination, the Examiner will interpret these recitations as meaning different types of image processing is performed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0053247 A1 to Sowinski et al. (hereinafter, Sowinski).

In regard to claim 19, Sowinski discloses a print-ordering system (**Sowinski, Fig. 5**) comprising:

print-control means (**Sowinski, [0065], line 6, networked computer system**) for transferring image data to a print system, where the image data is transmitted from a user terminal via a network (**Sowinski, [0065], lines 1-6**), and notifies the print system of image-processing mode of the image data and makes the print system execute print processing (**Sowinski, [0037], line 40, image printing, and [0071], lines 1-3, image reproduction that incorporates appearances selected by user, image reproduction includes printing**);

image-processing means (**Sowinski, [0135], lines 2-3, photofinishing service provider**) for performing image processing for one or more image used for selecting the image-processing mode (**Sowinski, [0127], lines 1-6, and Fig. 10 item 1004, rendered images are presented to user for selection**);

selection-inquiry means (**Sowinski, [0135], lines 2-3, photofinishing service provider**) for inquiring about which of the sample image stored in an image database in advance and the image data transmitted from the user terminal the user wants to select as an image-processing-mode-selection image (**Sowinski, [0135], lines 8-11, customer's image from a recent order pre-set is sample image stored; Fig. 4A, "I'LL PICK PICTURE LOOKS MYSELF" is image data transmitted from the user terminal**), transmitting the image-processing-mode-selection image to the user terminal and receiving information about a result of selection made by the user from among the

image-processing-mode-selection image (Sowinski, [0127], lines 1-6, and Fig. 10 item 1004, rendered images are presented to user for selection, according to Fig. 10, user is selecting, among other things, a first choice for image rendering – see category in Fig. 10 above item 1006); and

selection-result-storing means (Sowinski, [0129], lines 7-9, since the recitation of storing is given, a selection-result-storing means is inherent) for storing the selection-result information (Sowinski, [0129], lines 7-9, stored in file); and

a printer (Sowinski, Fig. 5, item 506 or item 507) for executing print processing in the image-processing mode (Sowinski, [0060]),

wherein the print-control means determines the image-processing mode of which the print system is notified based on the selection-result information stored in the selection-result- storing means (Sowinski, [0127], lines 1-9, and [0137], line 1 – [0138] line 5, profile is developed from user selection, profile is used to fulfill film processing).

In regard to claims 25 and 31, the claims recite essentially the same subject matter as claim 19, and are therefore rejected for the same reason as claim 19.

In regard to claims 20, 26, and 32, which depend from claims 19, 25, and 31, respectively, Sowinski discloses wherein the image- processing means performs multilevel-image processing for the image-processing mode (Sowinski, [0126], lines 3-12, multi-level processing includes picture look preferences) and the selection-

inquiry means transmits at least two image-processing-mode-selection images obtained by performing a multilevel-image processing to the user terminal so that the user makes selection, wherein each of the at least two image-processing-mode-selection images represents a different level of image processing of the image processing mode (Sowinski, [0127], lines 1-6, and Fig. 10 item 1004, rendered images are presented to user for selection, according to Fig. 10, user is selecting, among other things, a first choice through a fourth choice for image rendering – see category in Fig. 10 above item 1006).

In regard to claims 21, 27, and 33, which depend from claims 19, 25, and 31, respectively, Sowinski discloses wherein the image- processing means performs the image processing for any one of the sample image stored in the image database in advance (Sowinski, [0040], line 6, and [0127], lines 1-6, and category in Fig. 10 above item 1006) or the image data transmitted from the user terminal (Sowinski, [0135], lines 8-11, the disclosure of presenting one of the customer's image from a recent order inherently means that the image-processing means performs the image processing for image data transmitted from the user terminal. Moreover, Sowinski is directed to photofinishing (see Sowinski, [0002], lines 1-10), so its inherent that that the image-processing means performs the image processing for image data transmitted from the user terminal).

In regard to claims 22, 28, and 34, which depend from claims 21, 27, and 33, respectively, Sowinski discloses wherein the image-processing-mode-selection image is selected and the image processing is performed according to information about a result of the selection made by the user for the inquiry (**Sowinski, [0135], lines 8-11, customer's image; Sowinski, [0040], line 6, and [0127], lines 1-6, and category in Fig. 10 above item 1006, selection of sample image; Sowinski, Fig. 4A, left column of Fig. 4A under "SELECT LOOKS" heading and "MY PICTURES" heading. The categories in the left hand column of Fig. 4A are giving the user the option to select a previous picture ("MY PICTURES"), and a sample image ("SELECT LOOKS"))**).

In regard to claims 23, 29, and 35, which depend from claims 19, 25, and 31, respectively, Sowinski discloses means (**Sowinski, Fig. 4A**) for asking the user about a type of the image-processing mode in which the image-processing means performs the image processing via the user terminal (**Sowinski, Fig. 4A, left column of Fig. 4A, under "SELECT LOOKS" heading**), wherein the type of the image-processing mode is determined according to a result of selection made by the user for the inquiry (**Sowinski, [0054], lines 1-21**).

In regard to claims 24, 30, and 36, which depend from claims 19, 25, and 31, respectively, Sowinski discloses wherein the image- processing mode includes at least

one of outline emphasis, hue, color density, gradation, and contrast (**Sowinski, [0126], lines 3-12, hue**).

Response to Arguments

9. Applicant's arguments with respect to claims 19-36 have been carefully considered but are not persuasive.

In regard to the rejections of the claims, Applicant argues that Sowinski does not disclose "inquiring about which of the sample image stored in an image database in advance and the image data transmitted from the user terminal the user wants to select as an image-processing-mode-selection image." See Amendment, pg. 10. That is, Applicant is essentially arguing that the image that Sowinski selects is not a sample image, but is an image owned by Sowinski. See *Id.* While it may be true that Sowinski selects one of his previous images, this image is a sample image that has been stored, as the claims require. See, for example, Sowinski, [0040], and [0135]. Moreover, Applicant's claims do not require that the sample image be an image that is not owned by a user.

Accordingly, Applicant's arguments are not persuasive.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC A. RUST/

Examiner, Art Unit 2625

12/14/2009

/Benny Q Tieu/

Supervisory Patent Examiner, Art Unit 2625